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Attorney Docket No. 2950.01US02

REPLY BRIEF TRANSMITTAL

In re the application of:

KAMBE et al.

Confirmation No.: 6755

Application No.: 09/841,255

Examiner: C. Melissa Koslow

Filed: April 24, 2001

Group Art Unit: 1755

For: ABRASIVE PARTICLES FOR SURFACE POLISHING

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith, in triplicate, is the Reply Brief in the above-identified application, with respect to the Examiner's Answer dated March 22, 2004 and a Request for Oral Hearing.

Respectfully submitted,

*Peter S. Dardi*

Peter S. Dardi, Ph.D.  
Registration No. 39,650

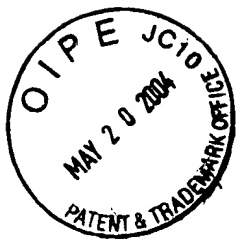
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May 17, 2004  
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*Peter S. Dardi*  
Peter S. Dardi



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 2950.01US02

Kambe et al.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF

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Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

In response to the Examiner's Answer of March 22, 2004, please consider the following remarks. Applicants only address particular issues raised in the Examiner's Answer. This Reply Brief is filed in triplicate.

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REMARKS

Status of Claims

The Examiner's statement on the status of the claims is correct.

Grouping of Claims

The Examiner asserts that claim 30 cannot stand or fall on its own since it depends from claim 26. With all due respect, the Examiner's assertion is incorrect. Referring to MPEP 1206 Appeal Brief Content, the only requirement for a separate claim group is an assertion that there is a distinct group as well as appropriate arguments for separate patentability. Applicants' have asserted properly a separate claim group for claim 30, and Applicants have presented a separate argument for patentability of claim 30 with respect to the Shimizu patent. Therefore, Applicants' placement of claim 30 in a separate group has met all of the requirements for separate consideration. Applicants are aware of no basis related to claim dependency as a limitation of asserting patentably distinct claim groups. In fact, a significant reason for having dependent claims is the possibility of separate patentability.

Obviousness-Type Double Patenting

The Examiner's statement that she is required to follow the procedures set forth in the most recent edition of the MPEP is noted. However, Applicants further note that the PTO has had NINE years to update these procedures since the implementation of the post-URAA patent term rules. The Examiner has not maintained in the Examiner's Answer any arguments against Applicants' assertions that the obviousness-type should never be applied against a first filed application over a later filed application. The fact that a very capable Examiner cannot formulate suitable rebuttal arguments should be a clear indication that correction of these outdated rules is long overdue.

With respect to Applicants assertions that a two way test should have been used, the Examiner refutes this argument by asserting that "the second part [of the two part test] has

not been met since there is no evidence of administrative delay in the part of the parent application, in 08/136,483, in 09/433,202 or in this application." But the Examiner is trying to have her cake and eat it too. It was the Examiner, in the Office Action of October 28, 2002, that justified the obviousness-type double patenting rejection of a first filed application based on a later filed application on the possibility of patent term extension. Patent term extension is the Congressional mandate that prescribes the boundaries of evaluating administrative delay. If the justification of the rejection is the possibility of patent term extension, then administrative delay must be presumed under the rational for justifying the rejection at all. The Examiner admitted in the Examiner's reply brief at page 9 that the first part of the test was met. Since the second part should be presumed, both prongs of the test have been met and a two way test should be applied, of course, assuming arguendo there is any justification of ever applying the rejection under the present circumstances, which there is not.

The Examiner further noted that Applicants filed a terminal disclaimer over 09/433,202 in the parent application for the present application. The Examiner did not explain the relevance of this statement, and Applicants do not see any relevance. The Appeal process is very costly and time consuming. Applicants have very limited resources. The fact that Applicants could not justify the time and expense in the parent application to challenge these outdated rules should not have any relevance here. Applicants respectfully request withdrawal of the obviousness-type double patenting rejections.

Rejection Over Shimizu Et Al.

The Examiner admits on page 9 of the Examiner's Answer that the figure in Shimizu et al. "is insufficient to evaluate if the particles are monodispersed or not." However, the Examiner relies on a statement in the Example and at column 3, lines 16-17 that the particles are "highly monodispersed." See page 10 of the Examiner's Answer. In particular, the Examiner asserts that "the statement that the particles are uniform means that the particles have a

uniformity of 100%." See Examiner's Answer at page 5. With all due respect, the Examiner's reliance on this simple statement is contrary to interpretation by a person of ordinary skill in the art and contrary to law.

As noted in Appellants' Brief, "In order to constitute anticipatory prior art, a reference must identically disclose the claimed compound..." MPEP 2122 citing In re Schoenwald, 22 USPQ2d 1671, (Fed. Cir. 1992). "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, **every element of the claimed invention must be identically shown in a single reference**. These elements must be arranged as in the claim under review, but this is not an 'ipsissimis verbis' test." In re Bond, 15 USPQ2d 1566, 1567 (Fed. Cir, 1990)(Internal citations omitted and emphasis added.).

With respect to the Examiner's interpretation of 100% uniformity, the language of Shimizu et al. certainly does not lead to this interpretation. Shimizu et al. equate the use of the term "uniform" with "highly monodispersed." See, for example, column 3, lines 12-17 and column 5, lines 65-68. These are clearly relative terms and cannot be interpreted to mean 100% uniformity. No person of ordinary skill in the art would interpret the description of nanoparticles as uniform as implying that they are 100% uniform since even the measurement of such a condition is impossible.

The Examiner further points to the Examples. However, only Example 1 comments on the uniformity by indicating that the particles are highly monodisperse. See column 6, lines 36-40. The particle size is evaluated by "turbidimetry," which would be expected to give no reliable information on uniformity. **The only support whatsoever for evaluating the degree of uniformity in the entire Shimizu et al. patent is Fig. 1.** See, column 6, lines 36-40. But the Examiner admits that Fig. 1 is insufficient to establish Applicants' claimed uniformity. Clearly, the Shimizu et al. patent does not teach Applicants' claimed invention essentially identically as claimed. Similarly, the disclosed particles do not necessarily

have the properties of Applicants' claimed particles. Therefore, the Shimizu patent does not literally or inherently anticipate Applicants' claimed invention.

The Examiner asserted at page 9 of the Examiner's Answer that Applicants had not addressed the teaching in Shimizu et al. in the Examples or at column 3, lines 16-17. However, on page 23 of Applicants' Brief, the issue of "highly monodisperse" powders was discussed in detail. Applicants do not see in the Final Office Action of August 8, 2003 a reference to column 3, lines 16-17. This issues regarding column 3, lines 16-17 is now addressed above.

With respect to the obviousness rejections, the Examiner asserted that Appellants' arguments were not convincing with respect to the anticipation rejection, and for the same reasons were therefore not convincing for the obviousness rejections. The arguments over the anticipation rejections are clarified above and apply now with equal force with respect to the obviousness rejections.

Applicants respectfully request withdrawal of the rejections over Shimizu et al.

#### Rostoker Patents

The Rostoker patents raise two issues. Specifically, what do the Rostoker patents teach and do they place Applicants' claimed inventions in the hands of the public.

First, the Examiner states on page 10 of the Examiner's Answer that "Applicant's state that the patents are directed to polishing substrates using the materials of the Siegel patent (5,128,081)." While the Rostoker patents may hint that the polishing material do not have to be made using the approaches described in the Siegel patent, that is certainly the primary focus of the Rostoker patents. And the Siegel patent is the **only** specific source cited for the polishing material in the Rostoker patents.

On page 11 of the Examiner's Answer, the Examiner stated that "with respect to Dr. Singh's declaration of 10 December 2001, the Examiner did not find Dr. Singh's criticisms of

one of the methods for determining the Q value in the patents as evidence that one of ordinary skill in the art could not determine the Q value." Professor Singh is an internationally recognized expert in the field. If an internationally recognized expert cannot determine the meaning of the distribution in the Rostoker patents, with all due respect, how could a person of ordinary skill or the primary examiner who examined the Rostoker patent. With all due respect, that simply is not reasonable.

On page 12, the Examiner states that "Appellant's claims do not exclude a 'tail in the distributions' in the claimed particle size distribution." But claim 15 effectively does exclude a tail. Claim 1 has other very specific attenuation of the particle size distribution.

With respect to enablement of the Rostoker patent, the Examiner argues that the Declaration discussed was not part of this application. However, Applicants referred to the parent arguments in the response to the first Office Action of this application, and the Examiner was the same person in both cases. Specifically, on page 7 of the Amendment of December 21, 2001, Appellants indicated the following:

As explained in detail in the Amendment of June 19, 2000, Applicants maintain that the Examiner has failed to establish prima facie anticipation and respectfully request the withdrawal of the rejection of claims 1, 3, 6-8, 15 and 23 under 35 U.S.C. §102(b) [sic 102(e)] over the Rostoker '715 patent and under 35 U.S.C. §102(b) over the Rostoker '194 patent.

Between the parent and this case, allowed claims were separated to issue, and there was continuity of argument as established by a reference to the parent case to incorporate those arguments.

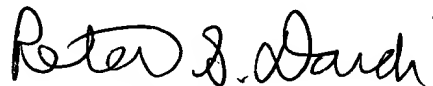
The Examiner proceeds on page 13 of the Examiner's Answer to cite her own evidence from the parent application with respect to an asserted citation of "a patent showing filtering of nanosized colloidal particles using filters having a mesh size of 2-1000 nm" from 1989. The Examiner cited this as rebuttal evidence of the Singh Declaration from the Office Action of August 25, 2000. With all due respect, Applicants could not find a reference to such a

patent in the Office Action of August 25, 2000. Presumably, this reference was made in a different Office Action. Nevertheless, the Rostoker patents do not teach filtering such that this art is not properly combinable with the Rostoker patents to establish enablement, and use of a mesh is extremely crude and cannot result in the type of uniformity claimed by Applicants. If filtering were a feasible way to obtain arbitrarily uniform particles, why was Siegel wasting their time trying to develop sophisticated techniques to produce better quality particles? The mere citation of mesh sizes falls far short of establishing the ability to produce the uniform particles claimed by Applicants. The Examiner has fallen far short of rebutting Professor Singh's Declaration, which is from an **expert** in the art.

SUMMARY

The Examiner has not establishing prima facie unpatentability based on all of the features of the claimed compositions. Therefore, the rejections should be withdrawn, and Applicants respectfully request such action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter S. Dardi".

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